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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1977

NO. 77-77-667

GAYETTA BARKER, EXECUTRIX OF
FRANK S. BARKER,
and
WILLIS G. PEHL

Petitioners,

v.

LUTRELLE F. PARKER, ACTING COMMISSIONER
OF PATENTS AND TRADEMARKS,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

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PETITION FOR WRIT OF CERTIORARI TO THE
COURT OF CUSTOMS AND PATENT APPEALS

Gayetta Barker, executrix of Frank S. Barker, and Willis G. Pehl petition for a Writ of Certiorari to review the opinion and judgment of the United States Court of Customs and Patent Appeals.

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals is

reported as *In re Barker and Pehl*, 194 USPQ 470 (1977), (Appendix C), affirming decisions of the Patent and Trademark Office Board of Appeals, the pertinent portions of which opinions are reproduced as Appendices A and B. A Petition for Rehearing of the CCPA opinion was filed on August 10, 1977 and was denied on September 15, 1977. The decision denying the Petition for Rehearing is Appendix D.

JURISDICTION

The original decision of the Court of Customs and Patent Appeals was decided July 21, 1977, and a Petition for Rehearing was filed on August 10, 1977 under Rule 6.1, authorizing a Petition for Rehearing to be filed within 21 days from the date of the decision. The jurisdiction of this Court is invoked under 28 U.S.C. 1256. This petition is timely filed within 90 days after the ruling of the Court of Customs and Patent Appeals on September 15, 1977 denying the Petition for Rehearing, in accordance with 28 U.S.C. 2101(c).

QUESTION PRESENTED

In construing the Patent Statute 35 U.S.C. 112, does the phrase "in such full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the same" modify "description"? Or is the statute to be construed that the phrase "in such full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the same" is a requirement of the statute completely separate from the written description [1] of the invention and [2] of the manner and process of making and using it?

Stated in another way, would a description that enables one skilled in the art to make and use the invention be a sufficient description of the invention for purposes of the statute?

STATUTE INVOLVED
35 U.S.C. 112 - FIRST PARAGRAPH

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in

such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

STATEMENT OF THE CASE

An application for patent was filed in the United States Patent and Trademark Office on September 9, 1974 by petitioners as Serial No. 504,317 for Prefabricated Shingle Panels, and the title was amended by the amendment filed September 9, 1974 to read Prefabricated Shingle Panel and Method of Making the Same. Claim 18 defining the method of making prefabricated shingle panels was rejected finally by the Examiner, and that rejection was appealed to the Patent and Trademark Office Board of Appeals.

The Board of Appeals reversed the rejection of the Examiner but entered a new ground of rejection, stating:

> "Claim 18 is rejected under 35 USC 112, first paragraph, as being

> based on a specification that fails to contain a written description of the invention defined in this claim." (Appendix A, page A-2)

A Request for Reconsideration of that rejection was filed with the Board of Appeals and, in the opinion and decision on that request for reconsideration, the Board stated:

> "...we noted in our rejection that we could not find a written description of the invention defined in this claim. We did not, in our first rejection of claim 18, indicate that there was lack of enablement or that one having ordinary skill in the art could not practice the invention, rather we dealt with only that part of the statute directed to the description. The first paragraph of 35 USC 112 sets forth three separate and distinct requirements; i.e., (1) description; (2) enablement; and (3) best mode. (In re Moore et al, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236.) It is this first element which is lacking here." (Appendix B, pages B-4 and B-5)

An appeal from the new rejection raised by the Patent and Trademark Office Board of Appeals was appealed to the Court of Customs and Patent Appeals

as authorized by 35 U.S.C. 141 on the basis of the record of the Patent and Trademark Office, and the Court of Customs and Patent Appeals rendered its opinion recorded in 194 USPQ 470, referred to above, Appendix C.

The opinion of the Court of Customs and Patent Appeals is in three parts, namely an opinion by Miller, Judge (Appendix C, pages C-1 through C-20), a concurring opinion by Rich, Judge (Appendix C, pages C-21 through C-23) and a dissenting opinion by Markey, Chief Judge (Appendix C, pages C-24 through C-27). Judge Baldwin dissented (Appendix C, page C-20).

REASONS FOR GRANTING THE WRIT

PRESTIGE OF THE CCPA

The CCPA is the only court in the United States specializing in patent cases. Direct appeals are taken to this Court from the United States Patent and Trademark Office, so that its decisions are binding on that Office. The decisions of the CCPA are rendered by five judges. Because of the number of judges of the CCPA making decisions

and the specialization of that Court in patent cases, its decisions should be highly authoritative and persuasive not only to all District Courts of the United States, but also to Circuit Courts of Appeal, even though the decisions of the CCPA are not actually binding on those courts. Consequently, it is important that the decisions of the CCPA be correct, clear and as unanimous as possible.

THE DECISION OF THE CCPA IS ANALOGOUS TO CONFLICTING COURT DECISIONS

The decision of the Court of Customs and Patent Appeals requested to be reviewed by the Supreme Court was not a unanimous decision, nor even a majority decision, but actually was decided by only two of the five judges of the CCPA. While the overall decision of the CCPA affirmed the decision of the Patent and Trademark Office Board of Appeals, the concurring opinion of Judge Rich was concurring only as to the result of affirmance. Chief Judge

Markey dissented with opinion and Judge Baldwin dissented. Actually, the opinion of Judge Rich disagreed with the opinion of Judge Miller on the question of statutory construction requested by this Petition to be reviewed by the Supreme Court.

In this connection, the concurring opinion by Judge Rich stated:

> "I agree with the result reached by the majority but, for a relatively uncomplicated case, the opinion unduly complicates matters....The decision is in accord with many of our prior interpretations of 35 USC 112 and there is no need to justify it by extensive review of the evolution since 1790 of the language of §112, first paragraph.
> 'Considering the evolutionary history of the language of §112, I do not subscribe to its interpretation through assumptions based on presumptions about usage of superfluous words and the like....
> "Particularly irrelevant, in my view, is any discussion of the wording of 35 USC 171 on designs, discussed by the majority in footnote 3....Attention must be paid to the key words 'such' and 'as to' in the phrase 'such full, clear, concise, and exact terms as to enable,' which compel case-by-case treatment of issues of the sufficiency of description and enablement..." (Emphasis supplied) (Appendix C, pages C-21 through C-23)

The opinion of Judge Miller, on the contrary, concluded with the statement

> "Thus, we need not reach the enablement issue." (Emphasis supplied) (Appendix C, page C-20)

The concurring opinion of Judge Rich concluded with the ambiguous characterization of "description" and "enablement" as

> "...distinct though commingled requirements." (Appendix C, page C-23)

Another factor motivating review by the Supreme Court is the emphatic character of the dissenting opinion by Chief Judge Markey which opens with the statement

> "I respectfully, but heartily, dissent." (Appendix C, page C-24)

Chief Judge Markey then quoted a key statement by the Board of Appeals that,

> "...'we did not, in our first rejection of claim 18, indicate that there was lack of enablement or that one having ordinary skill

in the art could not practice the invention, rather we dealt with only that part of the statute directed to the description.'" (Appendix C, page C-24)

followed by the excoriating statement

"How incongruous. How exaltive of form over substance. How illustrative of stare decisis rampant. The board is saying that it doesn't matter that one discloses an invention in such 'clear, concise and exact terms' (enablement) as to enable its practice, the very purpose and quid pro quo of the patent system from its inception." (Emphasis theirs) (Appendix C, pages C-24 and C-25)

Such judicial dissension among the five judges of the Court of Customs and Patent Appeals merits resolution by the Supreme Court not only for the guidance of the CCPA but for the Patent and Trademark Office that processes patent applications in the first instance, and all other United States courts, which are less expert then the CCPA in patent matters.

If the Supreme Court does not review and settle the construction of

35 U.S.C. 112, it can be expected that the interpretation of this statute will be in turmoil by the Patent and Trademark Office and by various courts for the foreseeable future.

35 U.S.C. 112 IS A FUNDAMENTAL FEDERAL PATENT STATUTE, THE CONSTRUCTION AND APPLICATION OF WHICH SHOULD BE WITHOUT QUESTION

35 U.S.C. 112 is a very important basic statute of patent law that has been in existence with minor changes for a period of almost 200 years. This period of time is ample for airing of all possible interpretations of that statute, and it is incredible that it should be subjected to such a split decision by a court specializing in patent law at this late day. Since the CCPA declined to revise its original decision on the Petition for Rehearing, the construction of 35 U.S.C. 112 can now be resolved only by a decision of the United States Supreme Court.

THE OPINION OF
JUDGE MILLER, IN ITSELF,
IS NOT CLEAR

The position of petitioners is well stated in the opening paragraph of the opinion by Judge Miller, as follows:

> "Appellants argue that the 'enablement' requirement of the first paragraph of 35 USC 112 cannot be read separately from the 'description' requirement therein.1/ They would interpret the phrase in section 112 'in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same' as modifying 'description'; thus, a sufficient description of the invention for purposes of the statute would be a description that enables one skilled in the art to make and use the invention." (Appendix C, pages C-8 and C-9)

With respect to this proposed construction of 35 U.S.C. 112, Judge Miller stated categorically

> "We do not agree." (Appendix C, page C-9)

Just what Judge Miller's construction of 35 U.S.C. 112 is, is not entirely clear. His ruling construction of 35 U.S.C. 112 appears to be embodied in

the following statement:

> "Accordingly, we reaffirm our recognition that 35 USC 112, first paragraph, contains separate requirements for--
>
> > "a written descripton [1] of the invention and [2] of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the same...." (Appendix C, pages C-16 and C-17)

It appears that Judge Miller places in one compartment

> a written description of the invention;

in a second compartment

> a written description of the manner and process of making and using the invention;

and in a third compartment, the dangling modifying phrase unattached to anything

> in such full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the same.

In an attempt to justify such a dismemberment of 35 U.S.C. 112, Judge Miller invokes a purported rule of statutory construction, stated as

follows:

> "As a principle of statutory construction, it is presumed that Congress did not use superfluous words."

Is it a more logical principle of statutory construction to interpret an adjective phrase as being completely divorced from a noun which it could modify? If the phrase

> "...in such full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the same,..."

does not modify "description", what does it modify? The opinion of Judge Miller does not purport to answer this question.

THE OPINION OF JUDGE MILLER IS IN CONFLICT WITH APPLICABLE DECISIONS OF THE SUPREME COURT

As stated above, Judge Miller purports to completely separate the "description" of 35 U.S.C. 112 from the so-called "enablement" phrase reading

> "...in such full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the same."

Supreme Court decisions, on the contrary, have consistently characterized the "description" required by 35 U.S.C. 112 as being one "in such full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the same." This modifying phrase is relied upon to determine whether the written description of the specification is adequate under the statute.

Representative pronouncements of the Supreme Court are:

> "...by the terms of the act of Congress, the inventor is not entitled to a patent unless his description is so full, clear, and exact as to enable any one skilled in the art to compound and use it." *Wood v. Underhill et al.*, 46 U.S. (5 Howard), 1, 5 (1847).

> "The statutes which are the source of all patent rights, provide that a valid patent may be granted for a new and useful machine, or for a new and useful improvement thereof (Rev. Stats., § 4886), but they require that every applicant for a patent shall file a written description of the manner and process of making and using his invention 'in such full,

clear, concise, and exact' terms as to enable any person skilled in the art to which it relates to make and construct it,..." (Emphasis supplied) *Beidler v. United States*, 253 U.S. 447, 453 (1920).

"...as the statute requires, the specifications just detailed show a way of using the inventor's method,...it is not necessary to embrace in the claims or describe in the specifications all possible form in which the claimed principle may be reduced to practice. It is enough that the principle claimed is exemplified by a written description of it and of the manner of using it 'in such full, clear, concise, and exact terms' as will enable one 'skilled in the art to make, construct, compound and use the same.'" (Emphasis supplied) *Smith v. Snow*, 294 U.S. 1, 24 USPQ 26, 30 (Sup.Ct. 1935).

JUDGE MILLER'S OPINION IS NOT EVEN SUPPORTED BY THE SUPREME COURT DECISIONS WHICH IT CITES

The Miller opinion refers to two Supreme Court decisions, one in footnote 4 and the other in footnote 5.

The decision of *Evans v. Eaton*, is cited in footnote 4 as 20 U.S. (7

Wheat.) 161 (1822). The page should be 356 instead of 161. In that case, one of the counsel commented on the forerunner of 35 U.S.C. 112 as follows at page 418:

> "To this end it enjoins that the applicant for a patent 'shall deliver a written description of his invention, and of the manner of using, or process of compounding the same; in such full, clear, and exact terms, as to distinguish the same from all other things before known; and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same.' This is the directory part. The thing is to be described 'so as to distinguish it from all other things before known.' How distinguish it? By describing all the things before known, and pointing out in terms in which it differs from them all? Certainly not; but by giving a description of it so complete and accurate, as 'to enable any person skilled in the art, &c. to make, compound, and use the same.'"

Note the direct coupling of the modifying phrase with "description." In its opinion, the Supreme Court commented on this statute at page 430 as follows:

> "It farther requires, that every inventor, before he can receive a patent, shall swear or affirm to the truth of his invention, ' and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all things before known, and to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same;..."

The Court did not separate this unitary description requirement into three arbitrary parts as was done by the Patent and Trademark Office Board of Appeals in this case and by the opinion of Judge Miller in the CCPA.

In *Evans v. Eaton*, the Court again referred to the same statute at page 433.

> "The third section of the patent act requires, as has been already stated, that the party 'shall deliver a written description of his invention, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science, &c. &c. to make,

> compound, and use the same.' The specification, then, has two objects: one is to make known the manner of constructing the machine (if the invention is of a machine) so as to enable artizans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. It is not pretended that the plaintiff's patent is not in this respect sufficiently exact and minute in the description. But whether it be so or not, is not material to the present inquiry. The other object of the specification is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented."

Again, the Court makes no attempt to separate the description from the modifying clause as to the sufficiency of the description to enable a person skilled in the art to make use of the invention.

Footnote 4 of the Miller opinion refers to the two objectives of the statute discussed above in the *Evans*

v. Eaton case, and notes that the 1793 Act did not require claims. The second object of the statute was subsequently removed by providing for the usual numbered claims of a patent which are separate from the description of the patent. Thus, the "description" requirement of the specification under the present statute 35 U.S.C. 112 has only one remaining object, namely:

> to enable artizans to make and use the invention.

Likewise, the Supreme Court case of *Gill v. Wells*, 89 U.S. (22 Wallace) 1 (1874), referred to in footnote 5 of the Miller opinion, does not trifurcate the patent description statute as the Miller opinion does. The Court there commented at the middle of page 25,

> "...that the inventor before he shall receive a patent for his invention, shall file in the Patent Office a written description of the same and of the manner of making, constructing, and using the same, in such full, clear, concise, and exact terms as to enable any person skilled in the art to make, construct, and use the invention."

The Court then applies that statute on

page 26 to a machine which consists of a combination of old ingredients stating:

> "Patents of that kind are much more numerous than any other, and consequently it is of the greatest importance that the description of the combination, which is the invention, should be full, clear, concise, and exact."

Note, again, the coupling with "description" of the phrase characterizing the type of description required. Footnote 5 of the Miller opinion fails to mention this discussion by the Supreme Court in the case of *Gill v. Wells*.

THE MILLER OPINION IS INCONSISTENT WITH PREVIOUS CCPA DECISIONS BUT DOES NOT OVERRULE THEM

Prior decisions of the Court of Customs and Patent Appeals do not compartment 35 U.S.C. 112. Consequently, the Miller opinion is inconsistent with those earlier CCPA decisions.

The case of *In re Olson*, 212 F2d 590, 685 OG 700, 101 USPQ 401 (CCPA 1954) ruled at page 403,

> "Under the patent statutes claims shall be allowed solely on

> condition that the applicant submits in his specification a written description of the invention in such full, clear, and exact terms as to enable any person skilled in the art to make, construct, and use the same. 35 U.S.C. (1952) §112. By compliance with this requirement, the progress of science and useful arts will be promoted." (Emphasis supplied)

Such inconsistent decisions of the CCPA can only cause confusion unless the earlier decision is specifically overruled in the later decision.

Other CCPA decisions which are inconsistent with the Miller opinion make the following statements:

"We do not think any person skilled in the arts encompassed by the foregoing quoted portion of the specification would be enabled by such a description to use all the products falling within claim 36....

> "The descriptions in patents are not addressed to the public generally, to lawyers or to judges, but, as section 112 says, to those skilled in the art to which the invention pertains or with which it is most nearly connected. The sufficiency of a specification must be tested in the

> light of this fact and judged by what it conveys to those who *are* skilled in the art. The judge's task is to decide whether from the disclosure the man skilled in the art can make the invention and use it. If he can, this part of the statute is complied with,..." (Emphasis supplied) (Italics theirs) *In re Wilke and Pfohl*, 50 CCPA 964, 314 F2d 558, 136 USPQ 435, 440, 441 (CCPA 1963)

"The first paragraph of § 112 requires nothing more than objective enablement." *In re Marzocchi & Horton*, 58 CCPA 1069, 439 F2d 220, 169 USPQ 367, 369 (CCPA 1971).

> "We find that the board's position in the present case is very similar to the position taken by the Patent Office in In re Argoudelis 58 CCPA 769, 434 F.2d 1390, 168 USPQ 99 (1970). In that case, the disclosure in the specification as filed was not sufficient by itself to enable one skilled in the art to make and use the invention." (Emphasis supplied) *In re Hawkins*, 486 F2d 569, 179 USPQ 157, 161 (CCPA 1973).

Clearly, the statutory construction proposed by the Miller opinion for 35 U.S.C. 112 is incompatible with the foregoing prior rulings of the CCPA.

THE MILLER OPINION IS INCONSISTENT WITH PREVIOUS STATEMENTS OF JUDGE MILLER

While the Miller opinion at page 6 and page 7, top, rules that the "description" requirement and the "enablement" requirement should be read and considered separately, in *In re Stephens, Benvau, and Benvau*, 529 F2d 1343, 188 USPQ 659 (CCPA 1976) Judge Miller stated:

> "A specification need be no more specific under Rule 71(b) than is required by the enablement provision of 35 USC 112. In re Gay, 50 CCPA 725, 309 F.2d 769, 135 USPQ 311 (1962). The test is whether there is sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation." (Emphasis supplied) (188 USPQ 659, 661)

It is petitioners' understanding that the position of the Miller opinion is that a specification which "enables" does not necessarily "describe" in compliance with 35 U.S.C. 112. Judge Miller stated the converse in *In re Armbruster*, 512 F2d 676, 185 USPQ 152 (CCPA 1975),

"Although appellant's specification

> describes the invention as broadly as it is claimed, thereby eliminating any issue concerning the description requirement, a specification which 'describes' does not necessarily also 'enable' one skilled in the art to make or use the claimed invention." (Emphasis supplied) (185 USPQ 152, 153)

It is appellants' position that where the description is sufficient to satisfy the "enablement" requirement of the statute, the "description" requirement is necessarily satisfied, because the "enablement" provision states to what extent the invention must be "described".

Moreover, in the *Armbruster* decision, Judge Miller quotes with approval from *In re Marzocchi & Horton*, 58 CCPA 1069, 439 F2d 220, 169 USPQ 367, 369, 370 (1971):

> "The first paragraph of § 112 requires nothing more than objective enablement." (Emphasis supplied) (185 USPQ 152, 153)

Why does the Miller opinion not apply this ruling of the *Marzocchi & Horton* decision in the present case as Judge Miller applied it in the *Armbruster* decision?

CONCLUSION

Only by an authoritative construction of the statute 35 U.S.C. 112 by the Supreme Court can order be restored to the chaos created by the Miller opinion as to the proper application in the future of the ancient requirement for a description in a patent. Consequently, it is considered that the granting of the requested Writ of Certiorari is amply justified.

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is hereby certified that on this ____ day of November, 1977, five copies of the printed PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS were served by first-class prepaid mail upon Joseph F. Nakamura, Solicitor, U.S. Patent and Trademark Office, Washington, D. C. 20231.

Robert W. Beach

CERTIFICATE OF SERVICE

It is hereby certified that on this ____ day of November, 1977, six copies of the printed PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS were served by first-class prepaid mail upon the United States Court of Customs and Patent Appeals, 717 Madison Place Northwest, Washington, D. C. 20439.

Robert W. Beach

CERTIFICATE OF SERVICE

It is hereby certified that on this ____ day of November, 1977, three copies of the printed PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS were served by first-class prepaid mail upon The Office of the Solicitor General, Department of Justice, Constitution Avenue and Tenth Street Northwest, Washington, D. C. 20530.

_____

Robert W. Beach

APPENDIX A

OPINION AND DECISION OF
BOARD OF APPEALS, JANUARY 27, 1976.

Before Williamowsky and Messenheimer, Examiners-in-Chief, and Boler, Acting Examiner-in-Chief.

Williamowsky, Examiner-in-Chief.

* * *

18. The method of making substantially uniform, regular modular prefabricated shingle panels which comprises selecting individual wooden shingles of at least three different predetermined widths, each shingle having a tip portion and a butt portion and being tapered in thickness away from the butt portion toward the tip portion, selecting elongated backing boards all of substantially the same predetermined length and width, each backing board having a length at least as great as the aggregate width of at least six shingles and of a width less than one-half the length of a shingle, laying the selected shingles of different predetermined widths in only a single course in each of at least two repetitive identical series, each series including at least three different selected, predetermined widths along the length of each backing board with their lengths extending transversely to the length of such backing board, with their tip portions overlying the backing board and with their butt portions overhanging one edge of the backing board in free cantilever fashion without any underlayer

for a distance at least as great as the width of the backing board and thereby forming substantially identical shingle arrangements in all panels with respect to such widths of the shingles, and securing the shingles to the backing boards in such arrangements only by their tip portions.

* * *

Under the provisions of 37 CFR 1.196(b), we enter the following new rejections.

Claim 18 is rejected under 35 USC 112, first paragraph, as being based on a specification that fails to contain a written description of the invention defined in this claim. Claim 18 is a method claim reciting four steps in a process of making substantially uniform regular modular prefabricated shingle panels. We fail to find in the specification a written description of these method steps. We do not consider that the "description" requirement is satisfied if one of ordinary skill in the art, after reading the specification, could conjure up the specific steps recited in this claim. See In re

Ahlbrecht, 58 CCPA 848, 435 F.2d 908, 168 USPQ 293 (1971); In re DiLeone et al, 58 CCPA 925, 436 F.2d 1404, 168 USPQ 592 (1971); In re Moore et al, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (1971).

Claim 18 is further rejected under 35 USC 112, first paragraph, as being based on a specification that does not enable one of ordinary skill in the art to practice the claimed invention and under 35 USC 132 for introducing new matter into the disclosure. This claim includes the step of "selecting elongated backing boards . . . each backing board having a length at least as great as the aggregate width of at least six shingles" (emphasis added). We have searched the specification and drawings in vain for a disclosure that the backing board's length must be at least six shingle widths. The only disclosure we can find is that the backing board's length is either eight or sixteen shingle widths. It is apparent that some criticality exists in the length of the backing board due to the spacing

of the underlying rafters. Since the scope of this claim clearly includes backing boards having a length of six shingle widths, we fail to find enablement commensurate with such scope. See In re Moore et al, supra at 239. Furthermore, we also find that such limitation adds new matter to the disclosure as proscribed by 35 USC 132.

The rejection of claims 17 and 18 under 35 USC 103 as being unpatentable over Fink et al in view of Lyman is reversed.

The rejection of claim 17 under 35 USC 103 as being unpatentable over Brady in view of Schuetz et al or Beckman is reversed.

The rejection of claims 17 and 18 under 35 USC 101 as double patenting of the same invention over the allowed claim 17 of parent application Serial No. 48,255 is reversed.

Under 37 CFR 1.196(b), a new rejection of claim 18 under 35 USC 112, first paragraph, "description" requirement is made.

Under 37 CFR 1.196(b), a new

rejection of claim 18 under 35 USC 112, first paragraph, "enablement" requirement and 35 USC 132, new matter, is made.

Any request for reconsideration or modification of this decision by the Board of Appeals based upon the same record must be filed within thirty days from the date of the decision. (37 CFR 1.197) Should appellants elect to have further prosecution before the examiner in response to the new rejections under 37 CFR 1.196(b) by way of amendment or showing of facts or both, not previously of record, a shortened statutory period for making such response is hereby set to expire thirty days from the date of this decision.

REVERSED 37 CFR 1.196(b)

/s/ David J. Williamowsky)
Examiner-in-Chief)
)
/s/ A. Donald Messenheimer) BOARD
Examiner-in-Chief) OF
) APPEALS
/s/ James R. Boler)
Examiner-in-Chief)
(Acting))

APPENDIX B

OPINION AND DECISION OF
BOARD OF APPEALS, MARCH 25, 1976.

Before Williamowsky and Messenheimer, Examiners-in-Chief, and Boler, Acting Examiner-in-Chief.

Williamowsky, Examiner-in-Chief.

ON REQUEST FOR RECONSIDERATION

This is a request for reconsideration of our decision of January 27, 1976 wherein we reversed the examiner's rejection of the appealed claims 17 and 18 and entered a new rejection under the provisions of 37 CFR 1.196(b) of claim 18. It is this new rejection of claim 18 which appellants ask us to reconsider.

Specifically, appellants contend that we were in error in rejecting claim 18 under 35 USC 112, first paragraph, as being based on a specification that fails to contain a written description of the invention defined in this claim, and in our further rejection of claim 18 under 35 USC 112, first paragraph, and under 35 USC 132 for introducing new matter into the dis-

closure.

In discussing the propriety of our second rejection of claim 18 under 35 USC 112, first paragraph (enablement), and 35 USC 132 new matter, we will set forth the manner in which the subject matter of claim 18 first appeared in the instant application. This application was filed under the provisions of 37 CFR 1.60 which states:

> "A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121), which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application. If the application papers comprise a copy of the prior application as filed, signing and execution by the applicant may be omitted provided the copy either is prepared and certified by the Patent Office or is prepared by the applicant and verified by an affidavit or declaration by the applicant, his attorney or agent, stating that it is a true copy of the prior application as filed. Certification may be omitted if the copy is prepared by and does not leave the custody of the Patent Office.

> Only amendments reducing the number of claims or adding a reference to the prior application (§1.78(a)) will be entered before calculating the filing fee and granting of the filing date."

Concurrently with the filing of this application on September 9, 1974, appellants filed a preliminary amendment wherein they submitted claim 18 with the found objectionable subject matter defined therein. Since the oath in the original application was utilized as the oath in the instant application in accordance with the above-noted provisions of 37 CFR 1.60, there was no valid oath directed to the subject matter of claim 18. Consequently, the subject matter as it appears in this method claim cannot be considered original subject matter in this case. We further note at this time that the original application to which the oath applied is directed to "A prefabricated shingle panel" or "An assembly of prefabricated shingle panels." Both appellants' original description and their original claims were so directed. Claim 18, however, is directed to "The

method of making substantially uniform, regular modular prefabricated shingle panels," a different statutory class of invention. Since the examiner did not question the propriety of such a claim being included in a 37 CFR 1.60 application, this issue was not before us and, consequently, no mention was made thereof in our decision. We have set forth the above-noted facts merely as background for our subsequent reconsideration of the propriety of our rejections of claim 18.

Turning now to the subject matter of claim 18 and its relation to the description, we noted in our rejection that we could not find a written description of the invention defined in this claim. We did not, in our first rejection of claim 18, indicate that there was lack of enablement or that one having ordinary skill in the art could not practice the invention, rather we dealt with only that part of the statute directed to the description. The first paragraph of 35 USC 112 sets forth three separate and distinct

requirements; i.e., (1) description; (2) enablement; and (3) best mode. (In re Moore et al, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236.) It is this first element which is lacking here. We have noted the numerous decisions cited by appellants; however, appellants, in the decisions cited in support of their contention, set forth the discussions therein dealing with the elements which we have designated as (2) and (3) rather than with element (1) called the description. Since appellants have not specifically pointed out wherein in the specification a method as claimed is described, we will, in the absence thereof, not reverse our position as to this ground of our rejection of claim 18.

Turning now to our second ground of rejection of claim 18. The claim requires a specific relationship between the number of shingles and the size of the length of the backing board. We find it immaterial that one reading the claim could conceivably

pick and choose shingle widths and then cut a board to fit the width claimed or to extend beyond the width. The relationship as disclosed in the application between the rafter spacing and the board length in order to prevent leakage appears, in our view, to be of a critical nature. To state as appellants have in their argument that the embodiments of Figures 7 or 10, each of which discloses a shingle width of more than six shingles, can be interpreted to support a limitation of at "least six shingles" or that backing boards can be spliced, begs the issue as to whether appellants' disclosure supports the lower limitation of six shingles. We consider our position in the instant case to be on a par with the holding of our appellant court based upon the facts of In re Ahlbrecht, 58 CCPA 848, 435 F.2d 908, 168 USPQ 293, wherein it was held that " . . . esters wherein m is 3-12 comprise the only genus described in full, clear, concise, and exact terms as required by the statute. Some esters wherein m is

2-12 clearly fall outside the class of esters described in the parent application" (emphasis ours). Here the step of "selecting elongated backing boards . . . each backing board having a length at least as great as the aggregate width of at least six shingles" (emphasis added) clearly falls outside the embodiments illustrated and described in the application.

We have considered appellants' argument that the claimed language is merely a broad statement of appellants' disclosure. However, the issue here is not whether appellants' invention is broadly claimed but whether there is support in the description of the specific manipulative steps set forth in the claim. Appellants argue that the decisions cited by the Board in support of their position all relate to chemical inventions whereas the present application relates to a mechanical process and then states: "The requirement of disclosure is much less stringent in mechanical cases than in chemical cases" (page 3 of the request). We

disagree with appellants' conclusion as it relates to the "description" requirement of 35 USC 112, first paragraph, which, as we stated supra, is separate and apart from the enablement portion of the statute. We know of no statutory requirement that compels us to apply a different standard to mechanical cases than that applied to chemical cases (see In re Mayhew, 188 USPQ 356, at page 357).

In summary, we have considered all of the arguments set forth in the request for reconsideration or modification of our decision, but find nothing whatsoever therein to convince us that the decision was in error.

The request is granted to the extent of reconsidering our decision

but is denied with respect to making any changes therein.

DENIED

/s/ David J. Williamowsky)
Examiner-in-Chief)
)
/s/ A. Donald Messenheimer) BOARD
Examiner-in-Chief) OF
) APPEALS
/s/ James R. Boler)
Examiner-in-Chief)
(Acting))

APPENDIX C

UNITED STATES COURT OF
CUSTOMS AND PATENT APPEALS

IN THE MATTER OF THE APPLICATION OF FRANK S. BARKER and WILLIS G. PEHL	)	Patent Appeal No. 76-659. Serial No. 504,317.

DECIDED: July 21, 1977

MILLER, Judge.

This appeal is from the decision of the Patent and Trademark Office Board of Appeals (board) rejecting claim 18 in application serial No. 504,317, filed September 9, 1974, for "Prefabricated Shingle Panels." We affirm.

The Invention

Appellants' invention is a method of making prefabricated panels of wooden shingles. Their amended specification describes the invention as follows (all italicized material added

by amendment; material deleted not shown):

> The theory of the regular modular panels shown in Figures 7 and 10 is that they are constructed according to a type established for the present invention by their shingles being of different selected predetermined widths to form a predetermined series or pattern which may repeat within a length of a panel, and which will repeat from panel to panel because of such regularity. The shingles used at corresponding locations in all panels will [sic] are alike in width and the shingles in all the panels are arranged in a corresponding predetermined series as to width, so that, if adjacent panels are offset by a predetermined amount, there will always be assurance that all of the cracks or joints between adjacent shingles in adjacent courses will be out of registration.

Figs. 7 and 10 of appellants' application are as follows:

Fig. 7.

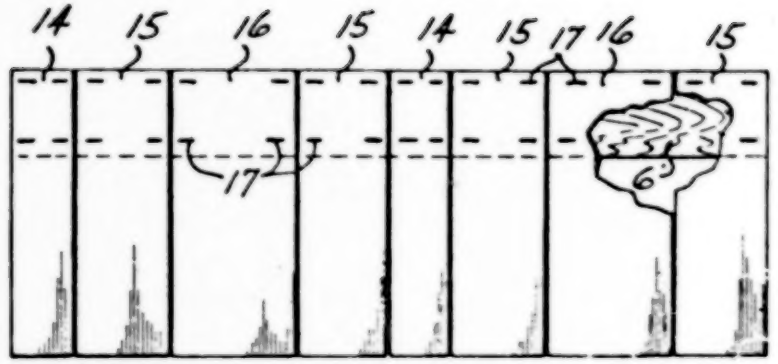
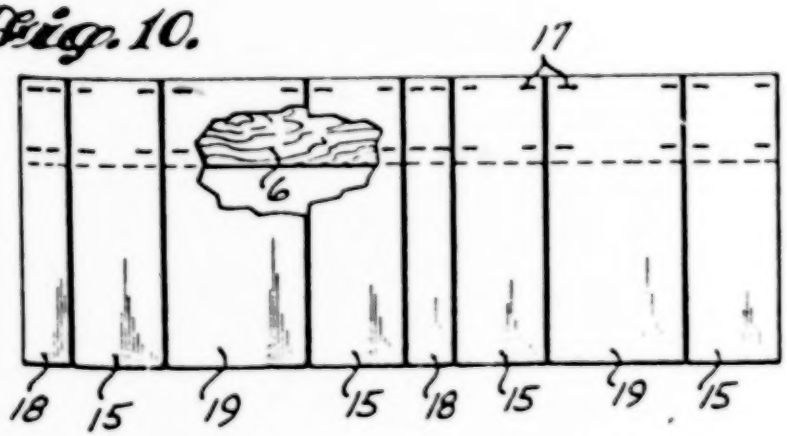


Fig. 10.



The specification continues:

> In the panel shown in Figure 7 the shingles 14 are nominally four inches in width, the shingles 15 are nominally six inches in width and the shingles 16 are nominally eight inches in width. Each panel is shown as being forty-eight inches in length and as being composed with the shingles arranged in the predetermined series or pattern 14, 15, 16, 15, 14, 15, 16, 15. In other words, the shingles in the series have the width pattern of 4", 6", 8", 6", 4", 6", 8", 6". These dimensions are nominal dimensions because it is preferred that the length of the panel be exactly forty-eight inches.
>
> . . . .
>
> The panel of Figure 10 is fabricated from shingles 15 which are six inches in width, shingles 18 which are three inches in width, and shingles 19 which are nine inches in width. The predetermined series of shingles is composed of the repetitive shingle pattern in this instance of 18, 15, 19, 15, 18, 15, 19, 15, providing a shingle nominal width pattern of 3", 6", 9", 6", 3", 6", 9", 6".
>
> Again, if shingle panels of the type shown in Figure 10 are assembled with the panels of

> adjacent courses offset lengthwise twelve inches, it will be found that each three-inch shingle 18 will be centered with respect to a nine-inch shingle 19 in the adjacent course both above and below it. In this instance also if the rafters or studs are located twelve inches on center and the panels are four feet or eight feet in length, each joint between the adjacent ends of adjacent panels will overlie a stud or rafter. Alternatively, suitable connecting means may be provided to connect the adjacent ends of adjacent backing boards without having a bearing member beneath the joint in each instance.

Claim 18, the sole claim on appeal, was introduced by an amendment and is directed to the method of making such shingle panels:

> 18. The method of making substantially uniform, regular modular prefabricated shingle panels which comprises selecting individual wooden shingles of at least three different predetermined widths, each shingle having a tip portion and a butt portion and being tapered in thickness away from the butt portion toward the tip portion, selecting elongated backing boards all of substantially the same predetermined length and width, each backing board having a

length at least as great as the aggregate width of at least six shingles and of a width less than one-half the length of a shingle, laying the selected shingles of different predetermined widths in only a single course in each of at least two repetitive identical series, each series including at least three different selected, predetermined widths along the length of each backing board with their lengths extending transversely to the length of such backing board, with their tip portions overlying the backing board and with their butt portions overhanging one edge of the backing board in free cantilever fashion without any underlayer for a distance at least as great as the width of the backing board and thereby forming substantially identical shingle arrangements in all panels with respect to such widths of the shingles, and securing the shingles to the backing boards in such arrangements only by their tip portions. [Emphasis supplied.]

The Rejections

The rejections by the examiner were based on prior art and on double patenting and were reversed by the board. Acting pursuant to its authority

under 37 CFR 1.196(b), it then entered three new rejections against claim 18: 35 USC 112, first paragraph, "as being based on a specification that fails to contain a written description of the invention defined in this claim"; 35 USC 112, first paragraph, "as being based on a specification that does not enable one of ordinary skill in the art to practice the claimed invention"; and 35 USC 132 for "introducing new matter into the disclosure." (The board's opinion makes clear that "disclosure" includes the claim.) The board specifically pointed to the step in claim 18 that recites "selecting elongated backing boards . . . each backing board having a length at least as great as the aggregate width of at least six shingles" (board's emphasis) as the basis for the rejections.

On appellants' request for reconsideration, the board declined to withdraw any of the rejections. It noted that claim 18 does not have the status of an original claim and that the limitation of "at least six shingles"

is outside the embodiments illustrated and described in the specification.

OPINION

Appellants argue that the "enablement" requirement of the first paragraph of 35 USC 112 cannot be read separately from the "description" requirement therein.[1/] They would interpret the phrase in section 112 "in such full, clear, concise, and exact terms as to

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1/ 35 USC 112, first paragraph, provides:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .

enable any person skilled in the art . . . to make and use the same" as modifying "description"; thus, a sufficient description of the invention for purposes of the statute would be a description that enables one skilled in the art to make and use the invention. We do not agree.

This court has clearly recognized that there is a description of the invention requirement in 35 USC 112, first paragraph, separate and distinct from the enablement requirement. In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974); In re Smith, 481 F.2d 910, 914-15, 178 USPQ 620, 623-25 (CCPA 1973); In re Moore, 58 CCPA 1042, 1047, 439 F.2d 1232, 1235, 169 USPQ 236, 238-39 (1971). A specification may contain a disclosure that is sufficient to enable one skilled in the art to make and use the invention and yet fail to comply with the description of the invention requirement. Fields v. Conover, 58 CCPA 1366, 1372, 443 F.2d 1386, 1391, 170 USPQ 276, 280 (1971); In re Ruschig, 54 CCPA 1551, 1558-59,

379 F.2d 990, 995-96, 154 USPQ 118, 123 (1967).[2/]

If, as urged by appellants, section 112, first paragraph reads--

> The specification shall contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . .

this would render superfluous the requirement that the specification contain a written description--

> of the manner and process of making and using it [the invention] . . . .

Obviously, if there were a description enabling "any person skilled in the art . . . to make and use," there would be no need to require a description of

---

2/ The above-cited cases completely answer the dissenting opinion's concern over exalting "form over substance" and its statement (with no citation of authority) that it cannot be seen how one may, in "full, clear, concise and exact terms," enable the skilled to practice an invention, and still have failed to "describe" it.

the "manner and process of making and using." As a principle of statutory construction, it is presumed that Congress did not use superfluous words.[3/] No evidence has been offered to rebut that presumption in this case.

3/ United States v. Menasche, 348 U.S. 528, 538-39 (1955) ("It is our duty to give effect, if possible, to every clause and word of a statute."); Platt v. Union Pacific R.R., 99 U.S. 48, 58 (1878) ("But the admitted rules of statutory construction declare that a legislature is presumed to have used no superfluous words. Courts are to accord a meaning, if possible, to every word in a statute."); In re Finch, 535 F.2d 70, 71, 190 USPQ 64, 65 (CCPA 1976) ("The repetition in 35 USC 171 of 'whoever invents,' 'any new,' and 'may obtain . . . title' would have been superfluous if the criteria of 35 USC 101 in their entirety were applicable to designs. We cannot assume that Congress did a useless thing in deleting 'useful' when it legislated with respect to designs.")

Commencing with our first patent statute, there have been separate requirements for a description of the invention and a description of how to make and use it. Section 2 of the Patent Act of 1790, ch. 7, 1 Stat. 109, 110, required the grantee of a patent to--

> deliver . . . a specification in writing, containing a description . . . of the thing or things . . . invented or discovered . . . which specification shall be so particular . . . as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art . . . to make, construct or use the same . . . . [Emphasis supplied.]

Section 3 of the Patent Act of 1793, ch. 11, 1 Stat. 318, 321, required that every inventor--

> deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any

> person skilled in the art or science . . . to make, compound, and use the same . . . .[4/] [Emphasis supplied.]

4/ The Supreme Court, in Evans v. Eaton, 20 U.S. (7 Wheat.) 161 (1822), interpreted this section of the statute as having two purposes: (1) to make known the manner of constructing the invention in order to enable artisans to make and use it, and (2) to put the public in possession of what the party claims as his own invention in order to ascertain whether he claims anything in common use, or already known, and to protect the public from an inventor "pretending that his invention is more than what it really is, or different from its ostensible objects . . . ." Id. at 196. (The 1793 Act did not require claims.) This court has recognized that the "essential goal" of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed. In re Smith, supra at 914, 170 USPQ at 624; In re Ruschig, supra at 1559, 379 F.2d at 996, 154 USPQ at 123 (1967). Whether that goal and the statutory requirement implementing it should be continued is, of course, a matter for the Congress to decide.

Section 6 of the Patent Act of 1836, ch. 357, 5 Stat. 117, 119, provided that an inventor--

> shall deliver [to the Patent Office] a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains . . . to make, construct, compound, and use the same . . . . [Emphasis supplied.]

See Phillips, The Law of Patents For Inventions 233 (1837), quoted in In re Nelson, 47 CCPA 1031, 1044, 280 F.2d 172, 181, 126 USPQ 242, 250-51 (1960). Section 26 of the Patent Act of 1870, ch. 230, 16 Stat. 198, 201, required that an inventor--

> shall file in the patent office a written description of the [invention], and of the manner and process of making, constructing, compounding and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it

> appertains . . . to make, construct, compound, and use the same . . . .[5/] [Emphasis supplied.]

5/ In discussing the description of the invention requirement of section 26 in a case involving a reissue patent for a machine being a combination of three elements (the original patent being to a combination of four elements), the Supreme Court in Gill v. Wells, 89 U.S. 1 (1874), stated:

> Even a glance at the original specification is sufficient to show that it does not contain any description whatever of the plate, deflector, or side guides mentioned in the specification of the reissued patent, nor is it pretended that if the several devices named had been described in the original specification the description of these several devices would have been a good description of the chamber or tunnel and its appendages which are embraced in the invention secured by that patent . . . . [Id. at 27.]

See also, 2 W. Robinson, The Law of Patents § 484, at 73 (1890), where the author states:

(cont'd)

Essentially the same language has been carried over into the present statute.

Accordingly, we reaffirm our recognition that 35 USC 112, first paragraph, contains separate requirements for--

> a written description [1] of the invention, and [2] of the manner and process of making and using it, in such full, clear, concise,

---

5/ (continued)

> According to the statutes, the Description must contain full explanations of three different subjects: the invention itself; the manner of making it; and the mode of putting it to practical use, --a complete knowledge upon all these points being necessary to render the invention available to the public without further experiment or exercise of inventive skill.

> and exact terms as to enable any person skilled in the art . . . to make and use the same . . . .[6/]

6/ Contrary to the dissenting opinion, the separate description of the invention requirement is not a mere "judicial (and unnecessary) response to chemical cases." It is a statutory requirement duly recognized by the courts--and not only in chemical cases. Evans v. Eaton and Gill v. Wells, both supra; In re Mott, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); In re Winkhaus, 527 F.2d 637, 188 USPQ 129 (CCPA 1975). The dissenting opinion's citation to In re Fisher, 57 CCPA 1099, 427 F.2d 833, 166 USPQ 18 (1970) is inapposite, that case having involved the scope of enablement and not the description of the invention requirement. Further, contrary to the suggestion in the dissenting opinion, the patent code does not prescribe a different standard between "complex" and "simple" cases; nor does this court apply different standards in such cases. In re Arkley, 59 CCPA 804, 455 F.2d 586, 172 USPQ 524 (1972).

Appellants do not contend that the step of selecting a backing board having a length equal to the width of at least six shingles is explicitly disclosed. However, they argue that, "[i]f a person skilled in the art wanted to provide a backing board and panel 48 inches in length with a repetitive pattern having only six shingles of three different widths, it would be obvious" how to do so. The fatal flaw in this argument is that motivation and enablement are not the issues; description of the invention is. As this court stated in In re Winkhaus, supra at 640, 188 USPQ at 131:

> That a person skilled in the art might realize from reading the disclosure that such a step is possible is not a sufficient indication to that person that that step is part of appellants' invention. Such an indication is the least that is required for a description of the invention under the first paragraph of § 112. See in re Smythe, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). Claims added by amendment and drawn to an invention not so described in the specification are drawn to "new matter" and prohibited by § 132.

We can find no indication in the specification or claims as originally filed that appellants invented the subject matter now claimed, particularly the step of "selecting elongated backing boards . . . each backing board having a length at least as great as the aggregate width of at least six shingles." (Emphasis supplied.) See In re Smythe, supra. The excerpts from the specification, supra, and the drawing figures indicate that appellants contemplated backing boards of four and eight foot lengths having a repetitive series of eight or sixteen shingles thereon. Thus, the limitation "at least six shingles" in the claim is not supported by the description of the invention in the specification or drawings and also constitutes new matter.

In view of the foregoing, the rejections of claim 18 under the description requirement of the first paragraph of 35 USC 112 and for new matter under 35 USC 132 are affirmed.

Thus, we need not reach the enablement issue.

AFFIRMED

BALDWIN, Judge, dissents.

UNITED STATES COURT OF
CUSTOMS AND PATENT APPEALS

IN THE MATTER OF THE APPLICATION OF FRANK S. BARKER and WILLIS G. PEHL	)	Patent Appeal No. 76-659. Serial No. 504,317.

RICH, Judge, concurring.

I agree with the result reached by the majority but, for a relatively uncomplicated case, the opinion unduly complicates matters.

The basic problem here is simple: new matter, in violation of 35 USC 132, was inserted by amendment and the claim contains that new matter. It therefore lacks support and must be rejected. The decision is in accord with many of our prior interpretations of 35 USC 112 and there is no need to justify it by extensive review of the evolution since 1790 of the language of §112, first paragraph.

Considering the evolutionary history of the language of §112, I do

not subscribe to its interpretation through assumptions based on presumptions about usage of superfluous words and the like. The words are of ancient lineage and, in spite of the fact they are inappropriate to some situations, they were preserved, in writing the Patent Act of 1952, because they were familiar and had many times been construed. Some simplifications and clarifications were made, but the classic phrases were retained without regard to "superfluous words." Mere reading of the successive statutes quoted by the majority shows that the words of §112 derive from an era when it was the habit of the legal fraternity to indulge in redundancies.

Particularly irrelevant, in my view, is any discussion of the wording of 35 USC 171 on designs, discussed by the majority in footnote 3.

While the majority opinion states, in footnote 6, that, in applying the statute, we have but a single standard for simple and complex cases, the fact is that different fact situations

demand different treatment. In re Nelson, 47 CCPA 1031, 1048, 280 F.2d 172, 184, 126 USPQ 242, 253 (1960). Attention must be paid to the key words "such" and "as to" in the phrase "such full, clear, concise, and exact terms as to enable," which compel case-by-case treatment of issues of the sufficiency of description and enablement which, I agree, are distinct though commingled requirements.

UNITED STATES COURT OF
CUSTOMS AND PATENT APPEALS

IN THE MATTER OF THE APPLICATION OF	)	Patent Appeal No. 76-659.
FRANK S. BARKER and WILLIS G. PEHL	)	Serial No. 504,317.

MARKEY, Chief Judge, dissenting.

I respectfully, but heartily, dissent.

The board, on reconsideration, said, "we did not, in our first rejection of claim 18, indicate that there was lack of enablement or that one having ordinary skill in the art could not practice the invention, rather we dealt with only that part of the statute directed to the description."

How incongruous. How exaltive of form over substance. How illustrative of stare decisis rampant. The board is saying that it doesn't matter that one discloses an invention in such "clear, concise and exact terms" (enablement) as to enable its practice, the very

purpose and quid pro quo of the patent system from its inception.

The attempt to create historical and current statutory support for a "separate description" requirement, which was solely a judicial (and unnecessary) response to chemical cases in which appellants were arguing that those skilled in the art "might" make and use a claimed invention, is mistaken.

There is no surplusage in saying, as the Congress in effect did, "* * * a written description of the invention * * * in such full, clear, concise, and exact terms as to enable," and "[a written description] of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable * * *." On the contrary, Congress saved words by specifying, in a single prepositional phrase, that the description of the invention, and the description of the manner of making and using it, shall both be in "such full, clear, concise, and exact terms as to enable." Section 112, first paragraph, is a simple sentence, with a comma

after "it," making the phrase "in such full * * * the same" a modifier of both objects of the verb "contain." All before that comma prescribes what shall be described. The phrase following the comma prescribes how and for whom it shall be described.

We should not hesitate to recognize that it would have been better if the court had held, in certain past chemical cases, that whatever "enablement" was present, it was not in "full, clear, concise and exact terms," rather than to have created a "separate description" gloss. We certainly should not hesitate to do so when the court finds its creation being bent out of shape, as here.

An illustration of the superfluousness of a separate "description" requirement lies in the board's use of the same alleged defect as the foundation for three rejections.

To employ the judicially-created "separate description" requirement, developed in complex chemical cases, to this simplest of mechanical inventions

is to disregard all that Judge Lane said for the court in In re Fisher, 57 CCPA 1099, 1108, 427 F.2d 833, 839, 166 USPQ 18, 24 (1970).

Contrary to the board's view, the number of shingles is not critical. Appellants' original claim 1 specified merely "a course of shingles." There is no rejection of the claim as open-ended. Appellants' shingles are disclosed as being of varying widths. Whatever the width and number of shingles available, every carpenter would use enough to cover the hole! Claim 18 just says that there is no infringement if less than six shingles are used.

I cannot see how one may, in "full, clear, concise and exact terms," enable the skilled to practice an invention, and still have failed to "describe" it.

Appellant disclosed eight shingles. I can't escape the view that eight includes "at least 6."

APPENDIX D

UNITED STATES COURT OF
CUSTOMS AND PATENT APPEALS

Thursday, September 15, 1977

Before: Markey, Chief Judge, Rich, Baldwin, Lane and Miller, Associate Judges and Almond, Senior Judge.

PETITIONS FOR REHEARING

No. 76-659. APPLICATION OF FRANK S. BARKER and WILLIS G. PEHL. The petition for rehearing is denied.

Supreme Court, U. S.
FILED
JAN 17 1978
MICHAEL RODAK, JR., CLERK

No. 77-667

In the Supreme Court of the United States

OCTOBER TERM, 1977

GAYETTA BARKER, EXECUTRIX OF THE ESTATE OF FRANK S. BARKER and WILLIS G. PEHL, PETITIONER'S

v.

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS and TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

WADE H. MCCREE, JR.,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

In the Supreme Court of the United States

OCTOBER TERM, 1977

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GAYETTA BARKER, EXECUTRIX OF THE ESTATE OF FRANK S. BARKER and WILLIS G. PEHL, PETITIONER'S

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MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

Petitioners seek review of the judgment of the United States Court of Customs and Patent Appeals affirming the rejection of petitioners' patent claim.

Petitioners applied for a patent based upon "a method claim reciting four steps in a process of making substantially uniform regular modular prefabricated shingle panels" (Pet. App. A-2). This claim (Claim 18) was made in an amendment to an earlier application which in turn was supported by specifications describing the invention (Pet. App. C-1 to C-6). By its terms, Claim 18 stated a specific relationship between the number of shingles and the size and length of the backing board by including a step of "selecting elongated backing boards

* * * each backing board having a length at least as great as the aggregate width of at least six shingles" (Pet. App. A-1).

The Patent and Trademark Office Board of Appeals rejected petitioners' claim in an original decision (Pet. App. A-1 to A-5) and on reconsideration (Pet. App. B-1 to B-9), on the separate grounds that the claim did not satisfy the "written description" requirement of 35 U.S.C. (Supp. V) 112,[1] and that the application contained "new matter" inserted by amendment in violation of 35 U.S.C. 132.[2] Although petitioners purported to claim a four step panel construction method, the Board "fail[ed] to find in the specification a written description of these method steps" (Pet. App. A-2). The Board rejected petitioners' argument "that the 'description' requirement is satisfied if

---

[1]35 U.S.C. (Supp. V) 112 provides in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

[2]35 U.S.C. 132 provides:

> Whenever, on examination, any claim for patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

one of ordinary skill in the art, after reading the specification, could conjure up the specific steps recited in this claim" (*ibid.*).

The Board found that the backing board length limitation of "at least six shingles" that appeared for the first time in Claim 18 was new matter. The Board "searched the specification and drawings in vain for a disclosure that the backing board's length must be at least six shingle widths" (Pet. App. A-3).

The United States Court of Customs and Patent Appeals (two judges dissenting) affirmed the rejections of Claim 18 both "under the description requirement of the first paragraph of 35 USC 112 and for new matter under 35 USC 132" (Pet. App. C-19).[3]

1. Petitioners' sole contention (Pet. 6-26) is that the Court of Customs and Patent Appeals incorrectly interpreted the patent description requirement of 35 U.S.C. (Supp. V) 112. The statute requires that the specification "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art * * * to make and use the same * * *" (*supra*, p. 2, n. 1). Petitioners argue (Pet. 12) that this provision is satisfied as long as the specification contains a "description that enables one

---

[3]Judge Rich, concurring, found it unnecessary to decide whether petitioners' specifications contained a sufficient written description of the invention, although he did acknowledge that description and enablement "are distinct though commingled requirements" (Pet. App. C-23). Judge Rich also agreed that petitioners' claim contained new matter made by amendment, in violation of 35 U.S.C. 132 (Pet. App. C-21).

skilled in the art to make and use the invention," and that it does not also require a separate description of the invention.

On its face, however, Section 112 imposes two requirements: (1) that there be a "description" of the invention and of the manner and process of making and using it, and (2) that such description be sufficiently clear that one skilled in the art may make and use the invention. As the plurality opinion below here stated "[t]he words are of ancient lineage * * * preserved, in writing the Patent Act of 1952, because they were familiar and had many times been construed" (Pet. App. C-22). Furthermore, as that opinion pointed out, "[c]ommencing with our first patent statute, there have been separate requirements for a description of the invention and a description of how to make and use it" (Pet. App. C-12). See *Evans* v. *Eaton*, 7 Wheat. 356, 433.

Since there is no compelling indication that Congress intended to alter the traditional statutory requirements in enacting the successive patent statutes (see Pet. App. C-12 to C-17), the Court of Customs and Patent Appeals has continued to recognize that "there is a description of the invention requirement in 35 USC 112, first paragraph, separate and distinct from the enablement requirement. *In re Bowen*, 492 F. 2d 859, 864, 181 USPQ 48, 52 (CCPA 1974); *In re Smith*, 481 F. 2d 910, 914-15, 178 USPQ 620, 623-25 (CCPA 1973); *In re Moore*, 58 CCPA 1042, 1047, 439 F. 2d 1232, 1235, 169 USPQ 236, 238-39 (1971)" (Pet. App. C-9).[4]

---

[4]Judge Markey's dissenting opinion appears to acknowledge this line of authority, although he argues "it would have been better if the court had held, in certain past chemical cases, that whatever 'enablement' was present, it was not in 'full clear, concise and exact terms,' rather than to have created a 'separate description' gloss" (Pet. App. C-26). But see *Application of Mott*, 539 F. 2d 1291, (C.C.P.A.); *Application of Winkhaus*, 527 F. 2d 637, (C.C.P.A.). Judge Markey also disagreed with the majority on the factual issue whether the number of shingles was critical and was new matter prohibited by 35 U.S.C. 135 (Pet. App. C-27).

Petitioners make no claim that their application satisfied the separate "description" requirement of the statute. The decision in this case, which merely "reaffirm[s the court's] recognition that 35 USC 112, first paragraph, contains separate requirements" (Pet. App. C-16), does not warrant further review.

2. In any case, the Court of Customs and Patent Appeals also correctly held that Claim 18 is deficient because "the limitation 'at least six shingles' in the claim is not supported by the description of the invention in the specification or drawings and * * * constitutes new matter" in violation of 35 U.S.C. 132 (Pet. App. C-19). Although "some criticality" exists in the length of the backing board (Pet. App. A-3), petitioners did not claim a new method of constructing panels of a six-shingle width in their original specifications; that limitation appeared for the first time in Claim 18 (Pet. App. C-19). But Claim 18 "was introduced by an amendment" (Pet. App. C-5), and 35 U.S.C. 132 provides that "[n]o amendment shall introduce new matter into the disclosure of the invention." Thus, as Judge Miller stated, concurring, "the basic problem here is simple: new matter in violation of 35 USC 132, was inserted by amendment and the claim contains that new matter" (Pet. App. C-21). Petitioner does not challenge and the record (Pet. App. A-3 to A-4) amply supports this factual determination, which independently supports the judgment below.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.,
Solicitor General.

JANUARY 1978.

DOJ-1978-01

Supreme Court, U. S.
FILED
FEB 14 1978
MICHAEL RODAK, JR., CLERK

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PETITIONERS' REPLY BRIEF

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PETITIONERS' REPLY BRIEF

This statement is in reply to points raised by the Solicitor General in the Memorandum For The Respondent In Opposition.

DISPARITY OF STATMENTS REGARDING DESCRIPTION REQUIREMENT

The Petition For Writ Of Certiorari To The Court Of Customs And Patent Appeals has been presented to enable the United States Supreme Court to resolve the confusion resulting from the conflict as to an asserted "separate description requirement" in 35 U.S.C. 112

(a) between different decisions of the Court of Customs and Patent Appeals (Pet. 21-23),

(b) between the decision of the Court of Customs and Patent Appeals and prior decisions of the U.S. Supreme Court (Pet. 14-21), and

(c) between different decisions of Judge Miller (Pet. 24-25).

Respondent's Memorandum has added to the confusion, thus emphasizing the importance of the Supreme Court granting the petition to resolve the disparity between different statements as to the alleged "separate description" requirement of the statute.

Some prior decisions of the Court of Customs and Patent Appeals simply stated that there was a "separate

description" requirement, i.e. separate from the "enabling" requirement, which interpretation apparently has not been challenged prior to the appeal in the present case. When Judge Miller attempted to "interpret" the statute in the decision in the present case, he presented an illogical construction of the statute (Pet. 13). The Respondent's Memorandum does not support the interpretation of Judge Miller but, instead, proposes a different interpretation of the statute as to a "separate description" requirement, thus confirming petitioners' position that the present state of confusion with respect to the statute requires clarification by the Supreme Court.

Judge Miller interprets the description requirement of the statute as follows (Pet. C-16 and C-17):

> "...35 USC 112, first paragraph, contains separate requirements for--
>
> "a written description [1] of the invention, and [2] of the manner and process of making and using it, in such full,

> clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . ." (Emphasis supplied)

Rather than supporting this interpretation of Judge Miller, the Respondent's Memorandum at page 4 states a different interpretation as follows:

> "...Section 112 imposes two requirements: (1) that there be a 'description' of the invention and of the manner and process of making and using it, and (2) that such description be sufficiently clear that one skilled in the art may make and use the invention."

In this statement, the Respondent has repeated the word "description" in the two "requirements" specified indicating that there are two adjectival clauses modifying "description." It is respectfully submitted that while this interpretation is not as illogical as that of Judge Miller, it is still not logical to chop the statute into two independent and unrelated requirements.

Viewing the matter in another way, Judge Miller stated petitioners' position as follows (Pet. C-8 and C-9):

> "They would interpret the phrase in section 112 'in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same' as modifying 'description';..."

Is that not precisely the position of Respondent's second requirement on page 4:

> "...and (2) that such description be sufficiently clear that one skilled in the art may make and use the invention." ?

Judge Miller states (Pet C-9, line 8):

> "We do not agree."

Thus Respondent is asserting an interpretation of the statute with which Judge Miller, who wrote the majority opinion of the Court of Customs and Patent Appeals decision, does not agree.

Only the Supreme Court can resolve the four-way split of statutory interpretation between the Respondent, Judge Miller, Judge Rich and Judge Markey.

DECISIONS CITED IN RESPONDENT'S MEMORANDUM

The prior decisions cited at the bottom of page 4 and in footnote 4 of

the Repsondent's Memorandum are really of no help in resolving the four aforesaid different interpretations of the statute because they either simply state categorically that there is a "separate description" requirement in the statute without attempting to really construe or interpret the statute, or other statements are made regarding the statute which are inconsistent with one or more of the four positions referred to above and, consequently, further confound the confusion.

Prefacing the citation of cases, the Respondent's Memorandum states:

> "...the Court of Customs and Patent Appeals has continued to recognize that 'there is a description of the invention requirement in 35 USC 112, first paragraph, separate and distinct from the enablement requirement." (Emphasis supplied) (Res. Memo. 4)

How do the decisions cited support this pronouncement?

In *In re Bowen*, 492 F. 2d 859, 181 USPQ 48 (CCPA 1974), the Court stated:

"The first paragraph of § 112

requires only that the specification enable any person skilled in the art to which the invention pertains to make and use the invention....The only other possible basis in the first paragraph of § 112 is the description requirement, relied upon by the solicitor, and dealt with next.

"The Description Requirement

"The solicitor's reliance on what this court has referred to as the 'description requirement' of the first paragraph of § 112 is misplaced. The so-called 'description requirement,' which exists in the first paragraph independent of the enablement (how to make and how to use) portions, serves essentially two functions. In the simple case, where no prior application is relied upon, the description requirement is that the invention claimed be described in the specification as filed." (Italics theirs) (182 USPQ 48, 52)

If the specification describes the invention in a manner which enables any person skilled in the art to which the invention pertains to make and use the invention, what more is required?

In *In re Smith and Hubin*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973), the Court

stated:

> "The board's opinion does not precisely set forth which of the several specific disclosure requirements of the first paragraph of § 112 is deemed not to be satisfied. We think that in its essence, the rejection is founded on the conclusion that the specification does not describe the invention as broadly as it is claimed. There is little language which is evocative of a position that the specification does not enable one skilled in the art to *use* the invention as broadly as it is claimed. However, we will deal with both the principal rejection based on the failure to satisfy the description requirement as well as a possible rejection based on the failure to satisfy the how-to-use requirement. We think it is clear that there has been no challenge to the specification disclosure with respect to either the manner of making the claimed invention or the best mode contemplated, and the solicitor does not contend otherwise.
>
> "The 'Description' Requirement
>
> "This court has repeatedly recognized a separate description requirement in the first paragraph of § 112. See In re Smith, 59 CCPA _____, 458 F.2d 1389, 1394, 173 USPQ 679, 683 (1972), and cases there cited." (Italics theirs) (178 USPQ 620, 623)

The Court, however, does not provide any interpretation as to where the language of the statute requires a "separate description." The Court goes on to say, however:

> "Compliance with the first paragraph of § 112 is adjudged from the perspective of the person skilled in the relevant art. This court has held that claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement,..." (178 USPQ 620, 624)

This statement suggests that, contrary to the ruling of Judge Miller, if, from reading the description of the specification, a person skilled in the particular art can understand how to make and use the invention, the "description" requirement is satisfied.

In *In re Moore and Janoski*, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971), the Court stated:

> "This first paragraph analysis in itself contains several inquiries. Considering the language of the

statute, it should be evident that these inquiries include determining whether the subject matter defined in the claims is described in the specification, whether the specification disclosure as a whole is such as to enable one skilled in the art to make and use the claimed invention, and whether the best mode contemplated by the inventor of carrying out that invention is set forth.

"Two of the first paragraph requirements indicated above, i.e., the 'description of the invention' and the 'best mode' requirements, are relatively simple to comply with..." (169 USPQ 236, 238 and 239)

Here again, it appears that, contrary to the ruling of Judge Miller, the 'description of the invention' requirement is satisfied if one skilled in the art can obtain sufficient information from the specification as to enable him to make and use the invention. What more is required?

This conclusion is confirmed by the further statement of the Court in the *Moore et al.* case that:

"What is of maximum concern in any analysis of whether a particular claim is supported by the disclosure in an application is whether that disclosure contains sufficient teaching regarding the subject matter of the claims as to enable one skilled in the pertinent art to make *and* to use the claimed invention. These two requirements, 'how to make' and 'how to use' have sometimes been referred to in combination as the 'enablement' requirement, but, in one form or another, have been the subject of extended discussion in this court of recent years. The relevant inquiry may be summed up as being whether the scope of enablement provided to one of ordinary skill in the art by the disclosure is such as to be commensurate with the scope of protection sought by the claims." (Italics theirs) (169 USPQ 236, 239)

Does this statement indicate that the statute has a "description" requirement <u>separate</u> from an "enablement" requirement?

In re Mott, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), stated:

"The § 112 rejections are based on the description requirement of § 112, first paragraph, as enablement and disclosure of best mode have not been questioned." (190 USPQ 539)

Here is simply a <u>categorical assumption</u>

that § 112 has a requirement for a "description" separate from the "enablement" provision, without any attempt to analyze or interpret the statute.

In commenting upon the "separate description" assumption, the Court stated:

> *"The Section 112 - Section 132 Rejection*
>
> "The issue under this heading is whether appellant's specification, construed in light of the knowledge of those skilled in this art, contains a written description of the subject matter of claims 42, 44, and 46." (Italics theirs) (190 USPQ 536, 541)

Is such issue to be considered entirely without regard as to whether the description is

> "...sufficiently clear that one skilled in the art may make and use the invention."

in the words of Respondent's Memorandum under item (2) at page 4, lines 7 to 9? If so, of what value is such a description?

Without quoting the language of the statute, the Court in the *Mott* decision

went on to state:

> "Appellant's application must contain sufficient disclosure, expressly or inherently, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed." (190 USPQ 536, 541)
>
> "...it does not matter under §112, first paragraph, *how* the specification describes the specific subject matter he later claims. The specification must merely do so in *some* way in order to comply with the description requirement. Accordingly, appellant need not have disclosed specific structures in order to have described the invention of claim 44 if his disclosure is otherwise adequate to show that he did in fact possess that subject matter." (Italics theirs) (190 USPQ 536, 542)

Would the "description requirement", Respondent's first requirement, be complied with if the description were not, in the language of Respondent's second and asserted separate requirement, sufficiently clear that one skilled in the art may make and use the invention?

In *In re Winkhaus, Tusche, and Kampf*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), the Court stated:

> "Although it may be *apparent*, as appellants argue, that the vapors of the reaction mixture at the end of a given heating zone *could* be utilized for heating the mixture flowing through this zone, that does not mean that such a step is *described* as part of their invention. That a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that that step is part of appellants' invention. Such an indication is the least that is required for a description of the invention under the first paragraph of §112." (Italics theirs) (188 USPQ 129, 131)

Should the description be considered with respect to a person skilled in the art <u>but entirely apart from the understanding which such a person might gain with respect to being able to make and use the invention</u>? How can a "<u>separate</u> description" requirement, as contended by Judge Miller, be satisfied <u>without</u> that description being sufficiently

> "...full, clear, concise, and exact...as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use

> the same,"

as recited in 35 U.S.C. 112?

It is evident that the foregoing decisions cited in Respondent's Memorandum do not attempt to analyze or interpret the specific language of 35 U.S.C. 112.

The Respondent's Memorandum concludes at the top of page 5 that the decision of the Court of Customs and Patent Appeals in this case does not warrant further review because that decision

> "...merely 'reaffirm[s the court's] recognition that 35 USC 112, first paragraph, contains separate requirements'..."

The difficulty is that the "separate requirements" of the statute proposed by Judge Miller (Pet C-16 and C-17) <u>are different</u> from the "separate requirements" set forth in Respondent's Memorandum at page 4, lines 4 to 9 as well as being different from the views of Judge Rich and Judge Markey. <u>Which</u> of these four inconsistent interpretations should be applied in future Court decisions? The previous decisions of the CCPA cited in

Respondent's Memorandum do not resolve this issue as shown by the foregoing quotations from them.

NEW MATTER QUESTION

The Respondent's Memorandum at page 5 points out that "in any case," presumably whether or not the Supreme Court should review the decision of the Court of Customs and Patent Appeals with respect to 35 U.S.C. 112, the judgment of the CCPA is supported independently by the adjudication of new matter. Actually, any issue as to the type of "new matter" asserted to exist in the present case is inextricably interwoven with the interpretation of 35 U.S.C. 112 and the actual determination of the case is controlled by the interpreation of that statute. This situation is indicated by the statement in the case of *In re Winkhaus et al.*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), cited at the bottom of page 5 of Respondent's Memorandum.

That the consideration of the

interpretation of § 112 is linked to such assertion of new matter under 35 U.S.C. 132 is indicated by repeating the last portion of the quotation above from the *Winkhaus et al.* decision and continuing it as follows:

> "Such an indication is the least that is required for a description of the invention under the first paragraph of §112. See In re Smythe, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). Claims added by amendment and drawn to an invention not so described in the specification are drawn to 'new matter' and prohibited by §132." (188 UPSQ 129, 131)

The interrelated character of these two considerations is further indicated by the decision of *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976) also cited by the Respondent in footnote 4, which stated:

> "The §112 rejections are based on the description requirement of §112, first paragraph, as enablement and disclosure of best mode have not been questioned. The §132 rejections are on the same basis." (Emphasis supplied) (190 USPQ 536, 539)

In the opinion, the heading is given

"The Section 112 - Section 132 Rejection" (Italics theirs) (190 USPQ 536, 541)

Under that heading the Court stated:

> "That Keithahn considered *his* valve to posses the function of response to well (and earth) surface conditions does not require the conclusion that a person skilled in the art would read appellant's mere description of automatic control means as encompassing the same function, i.e., response to conditions at the well surface, to show possession of the invention by appellant. The rejection of claim 46 under §112 and §132 is affirmed." (Italics theirs) (190 USPQ 536, 543)

The actual question which was considered by the Court was:

> "...what meaning persons skilled in the art would attribute to his disclosure for purposes of §112 and §132..." (190 USPQ 536, 541)

The case of *In re Bowen*, 492 F.2d 859, 181 UPSQ 48 (CCPA 1974) stated:

> "The solicitor's reliance on what this court has referred to as the 'descripton requirement' of the first paragraph of § 112 is misplaced....where no prior application is relied upon, the description requirement is that the invention claimed be described in the specification as filed. [citing cases] As such, a rejection on the description requirement is tantamount to a new matter rejection under 35 U.S.C. 132." (181 USPQ 48, 52)

The confusion and interrelationship between 35 U.S.C. 112 and 35 U.S.C. 132 in cases such as the present is therefore clearly such that one cannot be considered independently of the other.

MISINTERPRETATION OF "NEW MATTER" STATUTE

The Respondent's Memorandum on page 5 accurately quotes 35 U.S.C. 132 in part as follows:

> "'[n]o amendment shall introduce new matter into the disclosure of the invention.'" (Emphasis supplied)

Neither the Respondent's Memorandum nor any of the three opinions of the CCPA *Barker et al.* decision (Pet. App. C-1 to C-27) asserts that petitioners introduced new matter into the "disclosure" of the invention as specified in the portion of the statute quoted above and in the Respondent's Memorandum. There is, however, an error in Respondent's Memorandum on page 5 in quoting from the

decision.

There are two references to new matter in the decision, both of which are quoted in Respondent's Memorandum on page 5. The first quotation at lines 9 to 12 is by Judge Miller. The second quotation regarding new matter at Pet. App. C-21 quoted on page 5, lines 21 to 24, was by Judge Rich in the concurring opinion.

Note that each of these quotations refers to the statement in the claim and not in the disclosure as constituting the new matter. The decision does not discuss the "new matter" assertion at all.

The confusion between 35 U.S.C. 132 and 35 U.S.C. 112 is further emphasized by the statement of Judge Rich at Pet. App. C-21 immediately following the second quotation, as to new matter on page 5 of Respondent's Memorandum, the full quotation being:

> "...new matter, in violation of 35 USC 132, was inserted by amendment and the claim contains that new matter. It therefore lacks support and must be rejected. The decision

> is in accord with many of our prior interpretations of 35 USC 112..."

The Respondent's Memorandum appears to be somewhat misleading in the statement at the middle of page 5, namely,

> "Although 'some criticality' exists in the length of the backing board (Pet. App. A-3), petitioners did not claim a new method of constructing panels of a six-shingle width in their original specifications; that limitation appeared for the first time in Claim 18 (Pet. App. C-19)." (Emphasis supplied)

in three respects.

The first respect is the reference to "some criticality" with respect to the length of the backing board. Such "criticality" is the product of the imagination of the Patent and Trademark Office Board of Appeals. Actually, no such criticality exists because it was stated in petitioners' specification that suitable connecting means may be provided to connect the adjacent ends of adjacent backing boards without having a bearing member beneath the joint in each instance.

The second respect involves the statement that petitioners did not claim

a new method of constructing panels of a six-shingle width in their original specifications. Claim 1 did not specify any particular number of shingles, but claim 5, dependent on claim 1, specified that the shingles be arranged in a repetitive pattern, and claim 6, dependent on claim 5, specified that each shingle in the panel is one of three widths. Thus a repetitive pattern of three different shingle widths would be six shingles. Claim 18 does not specify "panels of a six-shingle width," however, but states "at least six shingles," as quoted on page 5, line 9, of Respondent's Memorandum.

The third respect is that claim 18 does not contain a "limitation" to "panels of a six-shingle width", but the claim specifies:

> "...at least three different predetermined widths..."

and

> "...at least six shingles." (Pet. App. A-1)

The Respondent's Memorandum concludes at the bottom of page 5:

> "Petioner does not challenge and the record (Pet. App. A-3 to A-4) amply supports this factual determination, which independently supports the judgment below."

What is the "factual determination" to which this statement refers?

CONCLUSION

It is respectfully submitted that the Respondent's Memorandum, instead of clarifying the situation, has emphasized the incorrectness of Judge Miller's interpretation of 35 U.S.C. 112, or at least the susceptibility of the statute to different interpretations by legal minds, so that this Honorable Court should grant the Petition for Certiorari and establish authoritatively the meaning of this statute to guide future decisions of lower courts.

Also, this Honorable Court should grant the petition to clarify whether simply broad language in a claim

constitutes "new matter" in the "disclosure," which is prohibited by 35 U.S.C. 132.

Respectfully submitted,

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RWB/bcm

February 1978.

CERTIFICATE OF SERVICE

It is hereby certified that on this ____ day of February, 1978, five copies of the printed PETITIONERS' REPLY BRIEF were served by first-class prepaid mail upon Joseph F. Nakamura, Solicitor, U.S. Patent and Trademark Office, Washington, D. C. 20231.

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It is hereby certified that on this ____ day of February, 1978, six copies of the printed PETITIONERS' REPLY BRIEF were served by first-class prepaid mail upon the United States Court of Customs and Patent Appeals, 717 Madison Place Northwest, Washington, D. C. 20439.

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Robert W. Beach